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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,644

06/20/2006

Chika Amishima

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Nields, Lemack & Frame, LLC
176 E. Main Street
Suite #5
Westborough, MA 01581

EXAMINER

FANG, SHANE

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

12/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,644	Applicant(s) AMISHIMA ET AL.	
	Examiner SHANE FANG	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-10, 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

The previous restriction has been made FINAL and **maintained**, as set forth in the previous action (see below response to argument).

Response to Amendment

- The amendment of specification and new claim 18 have been found supported by the original disclosure.
- The previous objection has been overcome by amendment.
- The previous 102 rejections of claims 2-8 over Koyanagi et al. have been **maintained**.
- The previous 102/103 rejections of claims 9-10 over Koyanagi et al. have been **maintained**.
- The previous 103 rejections of claims 2-10 over Nomura et al. in view of Nishikubo et al. have been **maintained**.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 2-8 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Koyanagi et al. (WO 0151991, machine translation of JP 2001192431 is used as English equivalent) listed on IDS.

Disclosure of Koyanagi et al. is adequately set forth in ¶4 of the previous action and is incorporated herein by reference.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Koyanagi et al. (WO 0151991, machine translation of JP 2001192431 is used as English equivalent) listed on IDS.

Disclosure of Koyanagi et al. is adequately set forth in ¶6 of the previous action and is incorporated herein by reference.

Claim Rejections - 35 USC § 103

5. Claims 2-10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomura et al. (US 5310862) in view of Nishikubo et al. (US 3923523).

Disclosure of Nomura et al. and Nishikubo et al. are adequately set forth in ¶7 of the previous action and are incorporated herein by reference.

Response to Arguments

The argument for allowance of amended claims has been fully considered but not persuasive.

The applicant has traversed the previous restriction and requested for withdrawn (Pg. 2, ¶3). The restriction has been **maintained** (see above rejection and below response to argument), because the issue of lack of unity remains.

The applicant has argued Koyanagi et al. fails to disclose the claimed polyamide acid having structure as shown in Pg. 4 of the argument (Pg.3, ¶5-10, ¶2, because the reaction sequence (scheme on Pg. 9) of the Koyanagi et al. is different from that of the claimed invention (scheme on Pg. 4). The examiner disagrees, in particular, the schemes provided by the applicant. As evidenced by Goodman et al. and Harris), general condensational polymerization, such as esterification by reacting dianhydrides with diols (Goodman et al., Pg. 29-30) and forming polyamic acid by reacting dianhydrides with diamines (Harris, Pg. 2) is actually a reversible process, wherein equilibrium between monomers and resultant polymers exists. No indication of non-reversible process for the polymerization has been shown in the claimed invention and the schemes in the argument. One of ordinary skill in the art would at once envisage that the sequence of the condensational polymerization in Koyanagi et al. would not make a difference in the structure of disclosed polyamide acid because of the reversible process. In light of this, the examiner asserts the previous product-by-process rationale, because no indication of structural difference has been presented by the

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applicant between the resultant products of Koyanagi et al. and the claimed polyamide acids. Therefore, the previous 102 and 102/103 rejections over Koyanagi et al. have been **maintained**.

The applicant has merely argued combining Nomura et al. and Nishikubo et al. would not result in the claimed polyamid acid without providing evidence (Pg. 12, ¶3-4). In light of the reversible process as set forth in the above ¶, the examiner asserts combining Nomura et al. and Nishikubo et al. would inherently results in the claimed polyamide acid. The examiner **maintains** the previous 103 rejections as set forth in the previous action, because one ordinary skill in the art would have combined the cited references and developed the claimed invention.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANE FANG whose telephone number is (571)270-7378. The examiner can normally be reached on Mon.-Thurs. 8 a.m. to 6:30 p.m. EST.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sf

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796